



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/587,108      | 06/02/2000  | Neil A Willcocks     | 02280.002620.       | 6805             |

5514 7590 01/20/2010  
FITZPATRICK CELLA HARPER & SCINTO  
1290 Avenue of the Americas  
NEW YORK, NY 10104-3800

|          |
|----------|
| EXAMINER |
|----------|

PHAM, THIERRY L

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2625

|           |               |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

01/20/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/587,108 | <b>Applicant(s)</b><br>WILLCOCKS ET AL. |  |
|                              | <b>Examiner</b><br>THIERRY L. PHAM   | <b>Art Unit</b><br>2625                 |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-65 and 83-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-65, 83-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

- This action is responsive to the following communication: RCE filed on 10/28/09 and supplemental amendment filed on 12/23/09.
- Claims 31-65, 83-97 are currently pending; claims 1-30 and 66-82 have been canceled.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/28/09 has been entered.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-65, 83-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Over et al (US 6538767), and in view of Zou et al (US 5800601).

Regarding claim 31, Over discloses a system (system 1, fig. 2) for enabling consumer (users or customers, col. 6, lines 5-8) to submit a customizable image (receiving customizable image or personalized image from consumer's computer remotely via LAN, WAN, Internet, col. 6, lines 5-17) to be printed directly on a non-planar surface (non-planar surfaces including ornaments, baseball, basketball, cups, blocks, cylinders, eggs, and etc, col. 5, lines comprising:

- a computer (imaging system 20, fig. 2), adapted to communicated (via LAN, WAN, or Internet communication network, col. 6, lines 5-15) with consumer's computer and enable the consumer's computer to communicate image data via a network (customizable image or

Art Unit: 2625

personalized image from consumer's computer remotely via LAN, WAN, Internet, col. 6, lines 5-17); and

- an ink-jet printer (ink-jet printer system 10, fig. 1, col. 5, lines 35-36) adapted to receive the image data from the computer and print directly on a non-planar surface (non-planar surfaces, col. 5, lines 1-17) a high quality image having a resolution greater than about 200 dpi (at least 360 dpi, col. 11, lines 15-40) that corresponds to the received image data in the manufacture of personalized objects (non-planar objects with personalized message or image, col. 6, lines 1-17), but Over does not specifically teach and/or suggest the object to be printed with personalized image is either a sugar shell candy or jellybean and a conveyor for conveying the sugar shelled candy or jellybean past a print head of the ink jet printer during printing in a single pass.

Zou, in the same field of endeavor for printing, teaches a method and a system for printing edible inks (abstract and col. 1, lines 13-17) on an edible products including sugar shell candy or jellybean (printing messages on food items such as fruits, chocolate candies, pharmaceutical tablets, and etc., col. 3, lines 35-60, col. 4, lines 25-28), and wherein the printing system further includes a conveyor (conveyor belt, col. 15, lines 54-65) conveying the sugar shelled candy or jellybeans (glazed candies including M&M candies, col. 15, lines 54-65) past a print head (conveyor belt for conveying candies past the print head, col. 15, lines 54-65) of the ink jet printer during printing (during printing, col. 15, lines 54-65) in a single pass (as the conveyor belt transported the candies by the print head, each candy was jet printed with the edible ink composition in a single pass, col. 15, lines 54-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify ink jet printing system of Over to include a conveyor for conveying the sugar shelled candies or jellybeans past a print head of the ink jet printer during printing in a single pass taught by Zou because of the following reasons: (1) able to print personalized messages on plurality of products including baseballs, footballs, eggs, sugar shelled candies, jellybeans, fruits, chocolates, and etc. (2) the ink drying time can be achieved in less than one second (see col. 15, lines 54-67 of Zou) to increase/improve output efficiency.

Therefore, it would have been obvious to combine Over with Zou to obtain the invention as specified in claim 31.

Art Unit: 2625

Regarding claim 32, Over further discloses a system according to Claim 31, wherein the network is the Internet (col. 6, lines 9-10). Over does not specifically teach and/or suggest a Web Browser runs on consumer computer adapted to send and receive Hypertext Markup Language (HTML) forms over the World Wide Web. Since system as taught by Over is implemented via using Internet and wherein Web Browser such as Internet Explorer or Netscape is widely available and well known installed on most consumer computer, therefore, it would have been obvious to include Web Browser on consumer/customer's computer that enable consumers/customers to send personalized image to manufacturer via using World Wide Web (Web Browser).

Regarding claim 33, Over further discloses a system according to Claim 31, wherein the network is a local area network (fig. 1).

Regarding claim 34, Over further teaches a system according to claim 31, wherein the ink-jet printer prints on the sugar shell or jellybean using a dispersed pigment food-grade ink (edible inks, col. 5, lines 1-49) to obtain a printed image having resolution greater than 200 dpi (col. 11, lines 25-40) even if printed using a single printhead and single pass printing.

Regarding claim 35, Over further discloses ink-jet printer is a drop-on-demand ink-jet printer (drop-on-demand ink-jet printer is well known and widely used in the print arts).

Regarding claim 36, Over further teaches wherein the printed image has a resolution between 300 and 1200 dpi (col. 11, lines 25-40).

Regarding claim 83, Over further teaches a system according to claim 31, further comprising a subsystem for holding (fig. 1, 9-10) the sugar shell candies or jellybean transiently in position and serially (the object may be mounted on a table that rotates the object to each successive position or may be mounted on an "assembly" that moves along a straight path between the print heads, col. 3, lines 19-24) transporting them past a printhead for printing.

Art Unit: 2625

Regarding claim 88, Over further teaches a system according to claim 31, wherein the customizable image is a personalized message (col. 6, lines 1-17).

Regarding claim 93, Over further teaches a system according to claim 31, further comprising an image processor adapted to process the image data and to allow the consumer to preview options (image preview 108 for allowing an operator to view the graphics that are to be applied to the objects, col. 12, lines 25-30, in addition, each consumer's computer includes a user interface display (e.g. monitor) that allows users/consumers to preview images and to adjust/modify (e.g. resize, cropping, color adjusting, and etc) the image before sending to the manufacturer) for decoration of said sugar shell candy or jellybean.

Regarding claims 37-65, and 84-87, 89-92, 94-97 recite limitations that are similar and in the same scope of invention as to those in claims 31-36, 83, and 88, and 93 above; therefore, claims 37-65, and 84-87, 89-92, 94-97 are rejected for the same rejection rationale/basis as described in claims 31-36, 83, and 88, and 93 above.

### ***Response to Arguments***

(1) Applicant's arguments, see pages 16-17, filed 10/28/2009, with respect to the rejection(s) of claim(s) 31, 37, 43, 48, 54, and 60 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art reference.

(2) The applicants argued the claimed invention was a commercial success with estimated of \$60 million in annual sales.

In response, it is not clear to the examiner if the commercial success was the results of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee or other business events. Furthermore, the \$60 million in annual sales is an estimated figure and does not reflect based upon an actual sales figure.

Art Unit: 2625

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THIERRY L. PHAM whose telephone number is (571)272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thierry L Pham/

Temporary Full Signatory Examiner, Art Unit 2625